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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/566,871	02/02/2006	Hiroshi Mukaihara	45010005211	2222

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EXAMINER	
GIARDINO JR, MARK A	

ART UNIT	PAPER NUMBER
2185	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/566,871	MUKAIHARA ET AL.	
	Examiner	Art Unit	
	MARK A. GIARDINO JR	2185	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/30/2009, 1/27/2010*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

The Examiner acknowledges the applicant's submission of the amendment dated 12/17/2009. At this point claims 9, 11, and 13 have been amended. Thus, claims 9-15 are pending in the instant application.

The instant application having Application No. 10/566,871 has a total of 7 claims pending in the application, there are 3 independent claims and 4 dependent claims, all of which are ready for examination by the examiner.

ACKNOWLEDGEMENT OF REFERENCES CITED BY APPLICANT

Information Disclosure Statement

The information disclosure statement filed 1/27/2010 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. “Let’s make a photo album by CD-R + digital camera – simple arrangement of photo data” has no English translation. It has been placed in the application file, but the information referred to therein has not been considered.

As required by **M.P.E.P. ' 609 (C)**, the applicant's submission of the Information Disclosure Statement, dated 9/30/2009, is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by **M.P.E.P. ' 609 C(2)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

REJECTIONS BASED ON PRIOR ART

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle (US 2001/0041021) in view of Parulski et al (5,633,678) and Goodman (US 6,704,824).

Regarding Claim 9, Boyle teaches a memory device of a portable type comprising: a terminal capable of being connected to an interface mounted on a host machine and capable of data input/output from/to said host machine **(I/O device 122, connected to host machine 110 via connection 130)**, and a storage element for storing data which include: at least one of image data and audio data **(note how JPEG images are stored in computer memory 220 in paragraph 0032)**, reproduction program data for said host machine to reproduce at least one of said image data and audio data **(see reproduction program description in paragraph 0032, also note the storage element can store the reproduction program and transfer it to the host, see paragraph 0010 and how the imaging conduit that contains the reproduction program is installed on the PC without the need for user interaction, i.e., when the storage element is first connected to the host)**, and execution program data for said

host machine to execute said reproduction program using said reproduction program data **(inherently present, since the host machine executes the reproduction program as described in paragraph 0032)**, a writing program to write at least one of said image data and audio data from said host machine to said storage element in response to a detection signal that said host machine detects a connection of said terminal to said interface **(the sync manager runs after the device is connected, as described in paragraph 0010, also see the description of the write program that uploads data from a personal computer 110 to the handheld electronic device 124, paragraph 0036)**, and install program data for installing the reproduction program data and the execution program data **(since the software program for the hotsync program is installed onto the PC, install program data is inherently present, Paragraph 0010)**.

However, Boyle does not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host **(left half of Figure 4 and Column 6 Line 60 to Column 7 Line 7)**. It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images

are transferred to the host system (as in Parulski) in the device of Boyle, since the user may not want all the images on the portable device in the host device.

Further, neither device explicitly teaches storing or installing driver program data on the host machine. Goodman teaches a driver program for operating a portable memory device on the host machine **(step 320 of Figure 3, where the peripheral device [corresponding to a portable memory device] uploads a driver to the host, also Column 2 Lines 30-32 and Column 4 Lines 38-65, and the driver is for operating the host, Column 1 Lines 38-43)**; and

install program data for installing the driver program data **(step 320 of Figure 3, where the driver is installed, thus install program data is inherently present to initiate the installation)**;

wherein the install program data automatically installs the driver program data on the host machine by connecting the portable memory to the host machine **(the process in Figure 3 and described on Column 4 Line 15 to Column 5 Line 15 requires no user intervention and begins upon connection of the device [Column 4 Lines 15-16], and the process is referred to as 'automatic' in the abstract, thus the driver program data is automatically installed)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the automatic driver installation of Goodman in the memory device of Boyle and Parulski because this avoids the need for external media in installing devices (Column 2 Lines 8-18 in Goodman).

Regarding Clam 10, Boyle, Goodman, and Parulski teach a portable memory device as described in Claim 9, wherein the host machine can activate said execution program in response to said detection signal to read and reproduce at least one of said image data and audio data stored in said memory element (the sync manager runs after the device is connected, as described in paragraph 0010, also see the description of uploading data from a personal computer to the handheld electronic device, paragraph 0036), when said host machine previously stores at least said reproduction program data and execution program data (imaging conduit 310 of the sync manager, installed on the host, paragraph 0010), and when said terminal is connected to said interface in the state that said storage element stores at least one of said image data and audio data (see Figure 6 and particularly steps 614, 618, and 620, where if the storage element stores an image and is connected, the imaging conduit that contains the reproduction program is run).

Regarding Claim 11, Boyle teaches a recording medium for storing a computer-executable program, the program having program code comprising:

a detecting step of detecting detection signal indicating that a terminal of a portable memory device is connected to said interface **(see how the sync manager runs after the device is connected, as well as an additional description in paragraph 0010 how the device runs without any need for user interaction)**; and

an executing step of executing a program in a reproduction program data for reproducing at least one of image data and audio data stored in said memory device, in

response to said detection signal **(see description of how the imaging conduit reproduces the image data in paragraph 0032, also note that the host executes this program, and thus an executing step is inherently present)**; and

a writing step to write at least one of said image data and audio data from a host machine to said storage element **(see description of writing the data from a personal computer to the handheld electronic device, paragraph 0036)**, an installing step of installing the reproduction program data **(since the software program for the hotsync program is installed onto the PC, install program data is inherently present, Paragraph 0010)**.

However, Boyle does not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host (left half of Figure 4 and Column 6 Line 60 to Column 7 Line 7). It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, since the user may not want all the images on the portable device in the host device.

Further, neither device explicitly teaches storing or installing driver program data on the host machine. Goodman teaches a driver program for operating a portable

memory device on the host machine **(step 320 of Figure 3, where the peripheral device [corresponding to a portable memory device] uploads a driver to the host, also Column 2 Lines 30-32 and Column 4 Lines 38-65, and the driver is for operating the host, Column 1 Lines 38-43)**; and

an installing step of installing the driver program data **(step 320 of Figure 3, where the driver is installed)**;

wherein the installing step automatically installs the driver program data on the host machine by connecting the portable memory to the host machine **(the process in Figure 3 and described on Column 4 Line 15 to Column 5 Line 15 requires no user intervention and begins upon connection of the device [Column 4 Lines 15-16], and the process is referred to as 'automatic' in the abstract, thus the driver program data is automatically installed)**.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the automatic driver installation of Goodman in the memory device of Boyle and Parulski because this avoids the need for external media in installing devices (Column 2 Lines 8-18 in Goodman).

Regarding Claim 13, Boyle teaches a data processing system comprising:

a host machine having an interface capable of data input/output **(computing device 110)**, and a portable memory device comprising a terminal capable of being connected to said interface **(paragraph 0020)**, and a storage element for storing at

least one of image data and audio data **(paragraph 0019)**, reproduction program data for said host machine to reproduce at least one of said image data and audio data **(see reproduction program description in paragraph 0032, also note the storage element can store the reproduction program and transfer it to the host, see paragraph 0010 and how the imaging conduit that contains the reproduction program is installed on the PC without the need for user interaction, i.e., when the storage element is first connected to the host)**, execution program data for said host machine to execute a program in said reproduction program data in response to a detection signal that said host machine detects a connection of said terminal to said interface **(see how the sync manager runs after the device is connected, as well as an additional description in paragraph 0010 how the device runs 'without any need for user interaction)**, a writing program to write at least one of said image data and audio data from said host machine to said storage element **(see description of writing data from a personal computer to the handheld electronic device, paragraph 0036)**,

wherein at least one of the image data and audio data to be reproduced is selected by a user **("the sync manager also provides the user the capability to change the data on one device…and subsequently synchronize the changed data with data located on the computing device", Paragraph 0024 in Boyle)**, and install program data for installing the reproduction program data **(since the software program for the hotsync program is installed onto the PC, install program data is inherently present, Paragraph 0010)**.

However, Boyle does not teach at least one of the image and audio data to be reproduced is selected via the host machine by a user, the selected data being not changed by a user.

Parulski teaches a media device holding pictures, which, when connected to a host computer, a user can select from the host device which categories of pictures the user wishes to transfer from the camera to the host **(left half of Figure 4 and Column 6 Line 60 to Column 7 Line 7)**. It would have been obvious to person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have allowed a user to select images via the host machine to determine which images are transferred to the host system (as in Parulski) in the device of Boyle, since the user may not want all the images on the portable device in the host device.

Further, neither device explicitly teaches storing or installing driver program data on the host machine. Goodman teaches a driver program for operating a portable memory device on the host machine **(step 320 of Figure 3, where the peripheral device [corresponding to a portable memory device] uploads a driver to the host, also Column 2 Lines 30-32 and Column 4 Lines 38-65, and the driver is for operating the host, Column 1 Lines 38-43)**; and

install program data for installing the driver program data, **(step 320 of Figure 3, where the driver is installed)**;

wherein the install program data automatically installs the driver program data on the host machine by connecting the portable memory device to the host machine **(the process in Figure 3 and described on Column 4 Line 15 to Column 5 Line 15**

requires no user intervention and begins upon connection of the device [Column 4 Lines 15-16], and the process is referred to as 'automatic' in the abstract, thus the driver program data is automatically installed).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to which the subject matter pertains to have implemented the automatic driver installation of Goodman in the memory device of Boyle and Parulski because this avoids the need for external media in installing devices **(Column 2 Lines 8-18 in Goodman)**.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle, Goodman, and Parulski in view of AppleCare Document: 122014.

Regarding Claim 12, Boyle, Goodman, and Parulski teach all limitations of Claim 11 as described above, wherein the program has code comprising

an outputting step of outputting at least one of said image data and audio data to said portable memory device (see description of outputting data from a personal computer to the handheld electronic device, paragraph 0036 in Boyle).

However, while Boyle mentions that images and 'other such data' (paragraph 0008) may be transferred across to the portable media device (also see paragraph 0036 where image data is downloaded to the portable device from a host device), he does not give an example of what this 'other data' may be. Apple's iPod, however, enables users to download software from Apple that is transferred from a host machine to the

iPod portable memory device automatically once it is connected to the host machine (see first paragraph of AppleCare Document: 122014).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to add a controlling step of controlling to output said image reproduction and execution data onto the host computer and to transfer this program to the handheld device during the outputting step just as the iPod Updater has a controlling step of controlling to output audio reproduction and execution data. The motivation for this is that it keeps software programs flexible, and any minor bug in a program on a handheld device would be able to fixed by uploading to the handheld device a new version of software from the host (see AppleCare Document: 122014 for a list of bug fixes in the iPod software, for example).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle, Goodman, and Parulski in view of Kahn (US 2004/0004737).

Regarding Claim 14, Boyle, Goodman, and Parulski teach all limitations of Claim 13 as addressed above. Boyle clearly has a network (218 in Boyle) in his system, but does not explain what data could be transferred over the network. Kahn teaches a network over which images are shared, including an external apparatus (image server 331-333 in Kahn). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains that Kahn's network could be the network in Boyle. In this combination, when a

device (such as handheld device 110) is connected to a host machine (such as 120 in Boyle) a program (such as the program specified in Kahn that begins at 522 in Figure 5, also see paragraph 0082) is run that uploads images to the external apparatus. The motivation for this comes from Kahn, who states that his network provides the benefits of automatic organization and easy sharing among friends (paragraph 0089 in Kahn).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Boyle, Goodman, and Parulski in view of Sesek (US 2003/0076365).

Regarding Claim 15, Boyle, Goodman, and Parulski teach all limitations of Claim 9 as addressed above. Boyle teaches a memory device of a portable type that can store images as well as programs for exchanging these images, but does not teach displaying these images as icons or as a reduced image of a file. However, Sesek teaches a technique that displays reduced images, or "thumbnails" of each image that can be displayed by a host machine (see paragraphs 0008-0011 in Sesek). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains to integrate this display system into the writing program that writes selected files to a portable memory device (such as that described in paragraph 0036 of Boyle). Motivation for this comes from Sesek, who states that thumbnails 'are useful for indicating the contents of a page or image' (paragraph 0007 in Sesek) and also that they allow the user 'to easily select pages or images for viewing' (paragraph 0006 in Sesek). Thus, by integrating Sesek's technique into the write program, additional benefits are obtained.

ARGUMENTS CONCERNING PRIOR ART REJECTIONS

Rejections - USC 102/103

Applicant's arguments with respect to claims 9-15 that neither Boyle nor Puralski teach “the install program data automatically installs the driver program data on the host machine by connecting the portable memory device to the host machine” has been considered but are moot in view of the new ground(s) of rejection.

CLOSING COMMENTS

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

STATUS OF CLAIMS IN THE APPLICATION

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. ' 707.07(i)**:

CLAIMS REJECTED IN THE APPLICATION

Per the instant office action, claims 9-15 have received a second action on the merits and are subject of a second action final.

DIRECTION OF FUTURE CORRESPONDENCES

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Anthony Giardino whose telephone number is (571) 270-3565 and can normally be reached on Monday - Thursday 7:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Sanjiv Shah can be reached on (571) 272 - 4098. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.A. Giardino

/M.G./

Patent Examiner
Art Unit 2185

March 15, 2010

/Stephen Elmore/
Primary Examiner, Art Unit 2185